

PATENT

Attorney Docket No.: A-65909-1/RFT/RMS/RMK



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BAMDAD, et al.

Serial No.: 09/135,183

Filed: August 17, 1998

For: ELECTRONIC DETECTION OF
NUCLEIC ACIDS USING
MONOLAYERS

Examiner: J. Lundgren

Group Art Unit: 1653

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OFFICE OF PETITIONS

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Number: EL659497272US

Date of Deposit: September 14, 2000

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on September 14, 2000.

Typed or Printed Name: VINCENT DIAZ

Signed: Vincent M. Diaz

PETITION UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner of Patents

Washington, DC 20231

Sir:

The following is a petition under 37 C.F.R. § 1.47(a) to accept the enclosed declaration, which is missing the signature of one of the co-inventors. Applicants hereby authorize the use of Deposit Account (No. 06-1300 (Our Order No. A-66343-1/RFT/RMS)) for the fee of \$130.00 as required under 37 C.F.R. § 1.17(i) in support of this petition.

The Commissioner is authorized to charge any additional fees which may be required or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A-66343-1/RFT/RMS).

Robin Silva is the attorney who prepared the above-identified application. In this application and in this petition under 37 C.F.R. § 1.47, she represents the interests of Clinical Micro Sensors, Inc. (Hereinafter "CMS").

Upon information and belief, the claims as filed were conceived and developed by Cynthia Bamdad. Cynthia Bamdad signed the original declaration as a sole inventor, and assigned the application to CMS.

However, during prosecution, claims were added that include Changjun Yu as an inventor (claims 20-22). Accordingly, the enclosed declaration, for Dr. Bamdad's and Dr. Yu's signature was prepared, and Dr. Yu executed it. However, in the interim between the original filing and the present, namely, on November 16, 1998, Dr. Bamdad terminated her employment with CMS.

At some later time, Dr. Bamdad instructed both myself and CMS to contact her only through her legal representatives, Mr. Norm Smith and Mr. Jerry Cohen, of Perkins, Smith & Cohen, 1 Beacon Street, Boston, Massachusetts 02108.

On September 8, 2000, our office sent a letter via Federal Express to Mr. Norm Smith advising him of the situation and requesting Dr. Bamdad's signature on the new declaration. The declaration was sent with the specification, the previously declaration signed by Dr. Bamdad, and the claims as allowed in the present case. This letter outlines that if Flehr did not receive the signed declaration by September 13, 2000, we would consider this deficiency to be an express refusal to sign the declaration. A copy of this letter is attached as Exhibit 1.

To date, Dr. Bamdad has not signed or returned the declaration.

Accordingly, as required by 37 C.F.R. §1.47 and M.P.E.P. §409.03(d), the applicants have met the requirements for proving a refusal to sign the declaration and assignment.

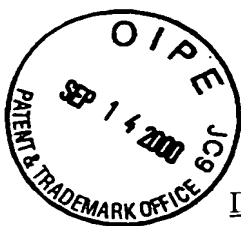
Dated: 9/14/00, 1999

Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT, LLP

By: Robin M. Silva
Robin M. Silva
Reg. No. 38,304

Four Embarcadero Center, Suite 3400
San Francisco, California 94111-4187
Telephone: (415) 781-1989
Facsimile: (415) 398-3249



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PATENT

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Assistant Commissioner for Patents, Washington,
DC 20231 on 9-17-00

under
37 CFR
1-10

Signed: Vincent M. Diaz
Gail Clark VINCENT DIAZ

**ASSIGNEE'S CONSENT TO INVENTORSHIP
CORRECTION UNDER 37 C.F.R. § 1.48(c)**

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Clinical Micro Sensors, Inc. is assignee of the captioned application as
evidenced by the assignment recorded at the Patent Office at Reel No. 9567, Frame
No. 0913. Clinical Micro Sensors, Inc. consents to the Petition to Correct
Inventorship filed herewith to add Changjun Yu as a co-inventor of this application.

The undersigned is authorized to act on behalf of Clinical Micro Sensors, Inc.

Date: 9/8/2000

By: Gary F. Blackburn

Name: Gary F. Blackburn

Title: V.P., Scientific Affairs



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Attorney Docket No.: A-65909-1/RFT/RMS/RMK

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) Examiner: J. Lundgren
)

) Group Art Unit: 1653
)

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) Service as First Class Mail in an envelope addressed to:
) Assistant Commissioner for Patents, Washington, DC 20231
) on *9-14-00*

) Signed: *Vincent M. Diaz* *under 37 CFR 1.10*
) *VINCENT DIAZ*

DECLARATION OF CHANGJUN YU

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

I, Dr. Changjun Yu, do hereby declare as follows:

1. I am Director of Chemistry at Clinical Micro Sensors, Inc.
2. The correction in inventorship in the above referenced patent application

is necessitated because of the addition of new claims 20-22 and occurred without
deceptive intent.

3. I have reviewed claims 20-22 and believe that I am an inventor of the
compositions claimed in these claims.

4. All statements made herein of my own knowledge are true and all
statements on information and belief are believed to be true. Furthermore, all statements
made by me herein are made with the knowledge that willful false statements and the
like so made are punishable by fine or imprisonment, or both, under Section 1001 of
title 18 of the United States Code, and that any willful false statements may jeopardize
the validity of any patent resulting therefrom.

Date: 9/8/2000

[Signature]
Changjun Yu



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OFFICE OF PETITIONS
Attorney Docket No.: A-69909-1/RFT/RMS/RMK

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BAMDAD, et al.

Serial No.: 09/135,183

Filed: August 17, 1998

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Examiner: J. Lundgren

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date indicated above and is addressed to the Assistant
Commissioner for Patents, Washington, D.C. 20231,
on September 14, 2000.

Typed or Printed Name: VINCENT DIAZ

Signed: Vincent M. Diaz

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PETITION TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.48(c)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Pursuant to 37 C.F.R. § 1.48(c), applicants request that Changjun Yu be added as an inventor. The application was filed with the name of Cynthia Bamdad as inventor. The correction of inventorship is necessitated because, while Cynthia Bamdad was correctly named as an inventor in the application as filed, the addition of new claims 20-22 requires the addition of Changjun Yu as an inventor.

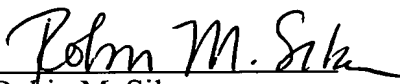
Included is the statement of Changjun Yu, attesting to the fact that the addition of new claims 20-22 during prosecution necessitated that he be added as an inventor and that the inventorship error occurred without any deceptive intent. Also included is the Assignee's Consent to Inventorship Correction.

The Commissioner is authorized to charge the \$130.00 fee for the petition, as set forth in §1.17(i), and any additions fees, including extension fees or other relief

which may be required or credit any overpayment to Deposit Account No. 06-1300
(our Order No. A-65909-1/RFT/RMS/RMK).

Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP


Robin M. Silva
Reg. No. 38,304

Four Embarcadero Center
Suite 3400
San Francisco, CA 94111-4187
Telephone: (415) 781-1989
1029399.RMK



POWER OF ATTORNEY BY ASSIGNEE
(Not Accompanying Application)

#18 *Pharmis*
28.01
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OFFICE OF PETITIONS

To the Commissioner of Patents and Trademarks:

The undersigned assignee of the entire interest in application for letters patent entitled: ELECTRONIC DETECTION OF NUCLEIC ACIDS USING MONOLAYERS

and having the named inventors: Cynthia Bamdad and Changjun Yu Serial No. 09/135,183 filed on or about the 17th day of AUGUST, 1998, hereby appoints the following attorneys to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith; said appointment to be to the exclusion of the inventor(s) and his (their) attorney(s) in accordance with the provisions of 37 C.F.R. 1.32: Harold C. Hohbach, Reg. No. 17,757; Aldo J. Test, Reg. No. 18,048; Donald N. MacIntosh, Reg. No. 20,316; Edward S. Wright, Reg. No. 24,903; David J. Brezner, Reg. No. 24,774; Richard E. Backus, Reg. No. 22,701; James A. Sheridan, Reg. No. 25,435; Robert B. Chickering, Reg. No. 24,286; Richard F. Trecartin, Reg. No. 31,801; Steven F. Caserza, Reg. No. 29,780; Robin M. Silva, Reg. No. 38,304; Edward N. Bachand, Reg. No. 37,085; David C. Ashby, Reg. No. 36,432; Maria S. Swiatek, Reg. No. 37,244; Dolly A. Vance, Reg. No. 39,054; R. Michael Ananian, Reg. No. 35,050; Stephen M. Knauer, Reg. No. 38,208; and Michael A. Kaufman, Reg. No. 32,998; provided that if any one of said attorneys ceases being affiliated with the law firm of Flehr Hohbach Test Albritton & Herbert LLP as partner, employee or of counsel, such attorney's appointment as attorney and all powers derived therefrom shall terminate on the date such attorney ceases being so affiliated.

In accordance with 37 CFR 3.73 the assignee hereby certifies that the evidentiary documents with respect to its ownership have been reviewed and that, to the best of assignee's knowledge and belief, title is in the assignee seeking to take this action.

Direct all telephone calls to ROBIN M. SILVA at (415) 781-1989.

Address all correspondence to:

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
Suite 3400, Four Embarcadero Center
San Francisco, California 94111

Assignee: CLINICAL MICRO SENSORS, INC.

By: Gary F. Blackburn, Ph.D.
TYPED NAME

Signature: *Gary F. Blackburn*

Title: Vice President, Scientific Affairs

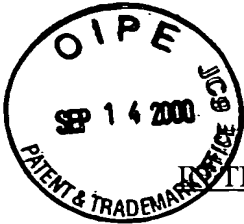
Address: 757 So. Raymond Avenue

Pasadena, California 91105

Date: 9/8/2000

File No. A-65909-1/RFT/RMS/RMK

1029405



PATENT

Attorney Docket No.: A-65909-1/RFT/RMS/RMK

THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Typed or Printed Name: VINCENT DIAZ

Signed: Vincent M. Diaz

DECLARATION OF ROBIN M. SILVA UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, ROBIN M. SILVA, declare that:

1. I am the attorney who prepared the above-identified application. In this application and in this petition under 37 C.F.R. § 1.47, I am representing the interests of Clinical Micro Sensors, Inc. (Hereinafter "CMS").

2. Upon information and belief, the claims as filed were conceived and developed by Cynthia Bamdad. Cynthia Bamdad signed the original declaration as a sole inventor, and assigned the application to CMS.

3. However, during prosecution, claims were added that include Changjun Yu as an inventor (claims 20-22). Accordingly, the enclosed declaration, for Dr. Bamdad's and Dr. Yu's signature was prepared, and Dr. Yu executed it. However, in the

interim between the original filing and the present, namely, on November 16, 1998, Dr. Bamdad terminated her employment with CMS.

4. At some later time, Dr. Bamdad instructed both myself and CMS to contact her only through her legal representatives, Mr. Norm Smith and Mr. Jerry Cohen, of Perkins, Smith & Cohen, 1 Beacon Street, Boston, Massachusetts 02108.

5. On September 8, 2000, our office sent a letter via Federal Express to Mr. Norm Smith advising him of the situation and requesting Dr. Bamdad's signature on the new declaration. The declaration was sent with the specification, the previously declaration signed by Dr. Bamdad, and the claims as allowed in the present case. This letter outlines that if Flehr did not receive the signed declaration by September 13, 2000, we would consider this deficiency to be an express refusal to sign the declaration. A copy of this letter is attached as Exhibit 1.

6. To date, Dr. Bamdad has not signed or returned the declaration.

7. Accordingly, as required by 37 C.F.R. §1.47 and M.P.E.P. §409.03(d), the applicants have met the requirements for proving a refusal to sign the declaration and assignment.

8. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. All statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: 9/14, 1999

Signed: Robin M. Silva
Robin M. Silva
Reg. No. 38,304

**FLEHR
HOHBACH
TEST
ALBRITTON
& HERBERT
LLP**

Intellectual Property Law

September 8, 2000

VIA FEDERAL EXPRESS

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OF COUNSEL
Julian Caplan
Jerry G. Wright

Thomas O. Herbert, Retired
Paul D. Flehr (1898-1992)
Immer S. Albritton (1922-1988)

Mr. Norm Smith
Mr. Jerry Cohen
Perkins, Smith & Cohen, LLP
1 Beacon Street
Boston, MA 02108-3106

Re: CMS patent application
Serial No.: 09/135,183
Filed: August 17, 1998
Entitled: *Electron Detection of Nucleic Acids Using
Monolayers*
Inventors: Bamdad, et al.
Our file: A65909-1/RFT/RMS/RMK

Dear Mr. Smith:

As a preliminary matter, we have not received a response to our letter of July 27, 2000, regarding instructions on whom further correspondence concerning intellectual property matters should be directed to. Thus, Peter Finn has been copied on this correspondence.

With respect to patent matters, I enclose a declaration, a copy of the specification and claims as allowed for patent application A-65909-1. Although Dr. Bamdad has already signed a declaration and assignment for this application as a sole inventor, we ask that Dr. Bamdad sign the enclosed declaration listing both herself and Dr. Changjun Yu as inventors. The addition of Dr. Yu is required because during the prosecution of the above referenced application new composition of matter claims 20-22 were added.

Although we do not believe that Dr. Bamdad should have any issues associated with signing the declaration, as she has already declared herself to be an inventor, we must have the signed declaration back in our office no later than **September 13, 2000**, as the issue fee must be paid by **September 14, 2000**. A self-addressed Federal Express envelope is enclosed for you to return the declaration to us.

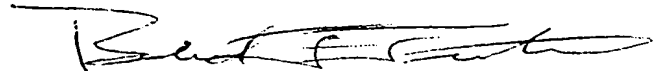
EXHIBIT !
=

Mr. Norm Smith
September 8, 2000
Page 2

We apologize for the delay in sending this material to you. However, if we do not hear from you by **September 13, 2000**, we will consider this to be an express refusal to sign the declaration.

Yours very truly,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP



Richard F. Trecartin

Enclosures
RMK:RFT

cc: Robin M. Silva, (w/o encl.)
Gary Blackburn (w/o encl.)
Richard Peers (w/o encl.)
Peter Finn (w/o encl.)

1029454.RMK